

REMARKS

Claims 1-22 are pending in this application. By this Amendment, claims 1, 5, 9, 11, 14, 15, 18 and 19 are amended, and claims 21 and 22 are added. Claims 1 and 11 are amended to recite features supported in the specification, for example, at paragraph [0034]. No new matter is added by any of these amendments.

Applicants appreciate the courtesies extended to Applicants' representative by Examiner Mackey during the November 5, 2004 interview. In accordance with MPEP §713.04, the points discussed during the interview are incorporated in the remarks below and constitute Applicants' record of the interview.

Reconsideration of the application is respectfully requested.

I. Claim 5 Satisfies the Requirements under 35 U.S.C. §112, second paragraph

The Office Action rejects claim 5 under 35 U.S.C. §112, second paragraph, as being indefinite. Claim 5 is amended to obviate this rejection in view of the Examiner's helpful comments. Withdrawal of the rejection under 35 U.S.C. §112, second paragraph is respectfully requested.

II. Claims 1-22 Define Patentable Subject Matter

The Office Action rejects claims 1-20 under 35 U.S.C. §102(b) over U.S. Patent 4,611,741 to Wilson (hereinafter "Wilson") incorporating U.S. Patent 4,473,425 to Baughman *et al.* (hereinafter "Baughman") by reference. As agreed during the interview, the claims define over the applied art of record.

In particular, neither Wilson nor Baughman teaches or suggests a substrate-compiling device including, *inter alia*, a compiler platform includes a first shelf member, and a second shelf member, the first and second shelf members that define a surface on which the received substrate is compiled onto, the first and second shelf members movable away from each other along a shelf-moving direction having a perpendicular translation component to the process

direction of the substrate, as recited in claim 1, and similarly recited for a method for compiling a substrate in claim 11.

In particular, Wilson and Baughman each disclose a binding apparatus. In particular, Wilson teaches a sheet processing apparatus 10 having a binder 16 and a receiving tray 24 for sheets S. From the receiving tray 24, the sheet S is driven by a curved sheet guide 50 to an assembly tray 54 that includes left and right portions 56, 58 that swing downward, enabling the assembled sheets to drop onto a guide 60. See col. 2, lines 31-42, 59-62, col. 3, lines 9-27, 48 – col. 4, line 19 and Fig. 1 of Wilson. Because Wilson teaches portions that pivot along axes that are parallel to the sheet, their movement does not include a direction component that is perpendicular to the downward direction of travel by the sheet, and therefore fails to teach or suggest all of the features recited in claims 1 and 11.

Further, Baughman teaches an apparatus 44 having guide plates 80 to direct sheets to a tray 108 equipped with a side edge jogger 126 to urge the sheet for alignment. See col. 5, line 66 – col. 6, line 24 and Figs. 3 and 4 of Baughman.

A claim must be anticipated for a proper rejection under §102(a), (b) and (e). This requirement is satisfied “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See MPEP §2131.

For at least these reasons, Applicants respectfully assert that the independent claims are patentable over the applied references. The dependent claims are likewise patentable over the applied references for at least the reasons discussed, as well as for the additional features they recite. Thus, Applicants respectfully request that the rejection under 35 U.S.C. §102 be withdrawn.

III. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-22 are earnestly solicited.

Should the Examiner believe that anything further is desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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JAO:GWT/gwt

Attachment:
Amendment Transmittal

Date: November 10, 2004

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